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REMARKS

This communication is responsive to the Office Action mailed on November 28, 2008. The Examiner has rejected claims 1, 6-16 and 19-22. Claims 1 and 16 have been amended to clarify the invention. Claims 23-27 have been cancelled. New claim 28 was added. Support for new claim 28 can be found throughout the specification, and in original claim 1. The Application currently includes claims 1, 6-16, 19-22 and 28. Reconsideration and allowance of the claims are requested.

The Office Action states that Group II of the Restriction, non-elected claims 2, 3, and 17, were re-filed as new claims 23-27, and thus, claims 23-27 were being withdrawn as directed to a non-elected invention. With this Amendment, claims 23-27 have been cancelled.

Claim 1 was rejected under 35 USC 112, second paragraph, as being indefinite. The "such as" phrase has been deleted from claim 1, and set forth in new claim 28 without the use of "such as". Withdrawal of the rejection and the addition of claim 28 are requested.

The Office Action rejected claims 1, 7-11, 16 and 20-22 as being obvious over Hamstra, U.S. Patent No. 6,442,988 ("Hamstra patent") in view of Sakakibara, U.S. Patent No. 5,727,411 ("Sakakibara patent"). The Office Action alleges that the Hamstra patent discloses a metal cylinder workpiece 10 having various diameters 11, 28 wherein the workpiece 10 is clamped down by a clamping device 16 and the workpiece and a first roller tool 20 are rotated relative to each other. The Office Action alleges that the workpiece is deformed by the first tool while the workpiece is moved along its axis of rotation. The Office Action alleges that a second forming tool 20b is placed into contact with the workpiece at a position behind the first tool and references, Figures 5a and 5b. The Office Action concludes that a tensile stress is produced between the roller tools and a mandrel 22 having a cylindrical region 23 and a tapered region 24. The Office Action states that Hamstra does not disclose that the roller forming tools are on a common holder. The Office Action alleges that the Sakakibara patent teaches that it is known to have a roller holder 20 for roller tools 31-33. Roller tools 31, 32 have roller portions 31b, 32b one behind the other engaging workpiece portions at different longitudinal portions of the workpiece. The Office Action states that it would have been obvious to one skilled in the art to

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mount the roller tools of Hamstra on a common holder as taught by Sakakibara in order to move the roller tools radially as a unit.

Applicant respectfully disagrees that independent claims 1 and 16 are obvious over the Hamstra patent in view of the Sakakibara patent. Independent claim 1 recites that the forming rollers associated with the first or second tools are mounted on a common holder and the holder is rotated about an axis which crosses said axis of rotation and/or radially adjusted during operation. Independent claim 16 contains similar limitations.

There is no disclosure in the Hamstra patent of a method of utilizing two tools on a common holder. Further, the device disclosed in the Hamstra patent is not capable of having two tools 20a and 20b mounted on a rotatable common holder. The Office Action acknowledges that there is no disclosure in the Hamstra patent of roller forming tools on a common holder, but alleges that Sakakibara teaches that it is well known to have a roller holder for roller tools.

Sakakibara does not supply the deficiencies in Hamstra. The apparatus shown in the Figures in the Sakakibara patent comprises a turn table 20 which has three rollers 31, 32, and 33. "The turn table 20 has a chuck, which is well-known as a part of a lathe, and the each [sic] of the rollers 31, 32 and 33 is sent to the work piece 10 by the chuck in the directions indicated by arrows C." Column 2, lines 31-34. Thus, the rollers are mounted on or comprise a holder that is movable relative to the turntable. Column 2, lines 23-24. The turn table in the Sakakibara patent is not a holder, as claimed.

It is instructive to see how Sakakibara characterizes the problem, and how this problem is solved. At Column 1, lines 21-44 Sakakibara states:

... if each of the forming rollers has a pair of parallel annular flanges and if the grooves of the male metal pipe are formed by the rollers at the same time, material (such as aluminium alloy or the like) of a wall 18 formed between the grooves 11 and 12 shown in FIG. 8 is pulled in directions indicated by arrows F and G. As a result, it is difficult to form the grooves 11 and 12 and the wall 18 into suitable shapes. ... [which] problem can be solved if each of the grooves is formed one by one. However, the productivity of the groove-forming is low, resulting in a high production cost. ...

In order to attain the above object of the present invention, a plurality of specific forming rollers are provided to correspond to the number of the grooves. Each of the forming rollers is positioned *at a different portion on a common circumference of the*

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metal pipe so that the forming rollers are pressed against the outer periphery of the metal pipe at portions different from each other. (emphasis added)

Thus, the Sakakibara patent expressly teaches that more than one roller on the same circumferential position should be avoided. The Sakakibara patent simply does not disclose two or more rollers on a common holder and, in fact, teaches that two or more rollers on a common holder should be avoided

In addition, in the Sakakibara patent, the forming rollers are moved only in a direction perpendicular to the axis of rotation, not "in a direction along said axis of rotation" as required by the independent claims of the present application.

Thus, the skilled person would not combine the Sakakibara patent with the Hamstra patent, and even if he would, he would not arrive at an embodiment according to the present invention. Sakakibara simply does not disclose, suggest or render obvious having two or more rollers on a common holder, and, in fact, teach that two or more rollers on a common holder should be avoided. Furthermore, the method and apparatus of Sakakibara are unsuitable for working the workpiece in a direction along the axis of rotation. Therefore, the Hamstra patent in view of the Sakakibara patent does not render obvious independent claims 1 and 16.

Reconsideration and allowance of claims 1 and 16 are respectfully requested

The Office Action also rejected dependent claims 7-11 and 20-22 as being anticipated by the Hamstra patent. While Applicant does not acquiesce to the rejection of dependent claims 7-11 and 20-22, Applicant submits that the rejections are moot in light of the fact that independent claims 1 and 16 are in allowable form. Withdrawal of the rejection is requested. Reconsideration and allowance of claims 7-11 and 20-22 and 28 are respectfully requested.

The Office Action also rejected dependent claims 6 and 19 under 35 USC § 103(a) as being unpatentable over the Hamstra patent in view of the Sakakibara patent and further in view of Zohler, U.S. Patent 4,765,058. The combination of the Hamstra patent, the Sakakibara patent and the Zohler patent does not overcome the deficiencies provided with respect to independent claims 1 and 16. Therefore, claims 6 and 19 are in allowable form. Reconsideration and

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allowance of claim 6 is respectfully requested.

The Office Action also rejected dependent claim 12 under 35 U.S.C. § 103(a) as being obvious over the Hamstra patent in view of the Sakakibara patent and further in view of Jenness, U.S. Patent No. 6,212,926. Applicant respectfully submits that the Jenness patent does not overcome the deficiencies of the Hamstra patent in view of the Sakakibara patent with respect to independent claim 1. Therefore, dependent claim 12 is not made obvious by the combination of the Hamstra patent in view of the Sakakibara patent and further in view of the Jenness patent. Reconsideration and allowance of claim 12 is respectfully requested.

The Office Action also rejected dependent claims 13-15 under 35 U.S.C. § 103(a) as being obvious over the Hamstra patent in view of the Sakakibara patent and further in view of Wall, U.S. Patent No. 6,601,284. Applicant respectfully submits that the Wall patent does not overcome the deficiencies of the Hamstra patent in view of the Sakakibara patent with respect to independent claim 1. Therefore, dependent claims 13-15 are not made obvious by the combination of the Hamstra patent in view of the Sakakibara patent and further in view of the Wall patent. Reconsideration and allowance of claim 12 is respectfully requested.

The foregoing remarks are intended to assist the Office in examining the application and in the course of explanation may employ shortened or more specific or variant descriptions of some of the claim language. Such descriptions are not intended to limit the scope of the claims; the actual claim language should be considered in each case. Furthermore, the remarks are not to be considered exhaustive of the facets of the invention which are rendered patentable, being only examples of certain advantageous features and differences, which applicant's attorney chooses to mention at this time. For the foregoing reasons, applicant reserves the right to submit additional evidence showing the distinction between applicant's invention to be unobvious in view of the prior art.

Furthermore, in commenting on the references and in order to facilitate a better understanding of the differences that are expressed in the claims, certain details of distinction between the same and the present invention have been mentioned, even though such differences do not appear in all of the claims. It is not intended by mentioning any such unclaimed

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distinctions to create any implied limitations in the claims.

For the foregoing reasons, Applicant submits that the present application is in allowable form. Allowance of the present application is respectfully requested.

A two month extension of time is hereby requested for responding to the Office Action. A charge authorization for the extension of time fee is included herewith.

The Director is authorized to charge any fee deficiency required by this paper or credit any overpayment to Deposit Account No. 23-1123.

Respectfully submitted,

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